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TO: Commissioner for Patents

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COMMENTS: Transmitted herewith is an Election for the following application:

App. No.: 10/673,686 Confirmation No.: 1295

Applicant: Eldridge et al. Filed: September 29, 2003

TC/A.U.: 2829 Examiner: Ernest F. Karlsen

Docket No.: P7D7C2-US

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Erin Cowles

Ref. No. P219-5036

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/673,686	Confirmation No. 1295
Applicant	:	Eldridge et al.	
Filed	:	September 29, 2003	
TC/A.U.	:	2829	
Examiner	:	Ernest F. Karlsen	
Docket No.	:	P7D7C2-US	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION

To Whom It May Concern:

In response to the Restriction of September 29, 2005, the shortened statutory period for response to which ends after October 31, 2005 (the first business day following October 29, 2005), Applicants hereby elect with traverse the claim of Group XIV, namely, claim 71. Applicants traverse the Restriction as follows.

The Restriction fails to show that the criteria for restriction stated in the Restriction are met. The Restriction states "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together ***and*** they have different modes of operation, different functions or different effects." (Emphasis added) The Restriction thus sets forth a two element test: (1) the inventions are not disclosed as capable of use together, and (2) the inventions have different modes of operation, different functions, or different effects.

The Restriction does not establish that either element of the test is met for all 15 inventions identified in the Restriction. Indeed, that "the different inventions are each to a different combination with claim 47 being a subcombination common to all of the combinations" establishes neither that the 15 groups of inventions are incapable of use together nor that the 15 groups of inventions have different modes of operation, functions, or effects. In fact, all dependent claims are, by definition, different combinations of the parent claim. If that mere fact

were sufficient to support a restriction, then all dependent claims in all patent applications would be restrictable as drawn to independent, unrelated inventions.

Because the Restriction thus does not establish that each of the 15 groups of inventions are not usable together and have different modes of operation, different functions, or different effects, the restriction requirement cannot stand.

Moreover, the MPEP makes clear that inventions must be completely unrelated—that is, entirely unusable together—to be restrictable as drawn to unrelated, independent inventions. Two examples given in the MPEP are a shoe and a locomotive bearing, and a process of painting a house and a process of boring a well. (MPEP § 806.04.) The MPEP also states that "[t]his situation . . . is but rarely presented, since persons will seldom file an application containing disclosures of independent things." (MPEP § 808.01.) As the MPEP thus states is to be expected, the claims pending in the instant application are not unrelated. In fact, one wonders when, if ever, claims that depend from the same parent claim could be unrelated.

Here, the 15 groups of inventions identified in the Restriction are not unrelated and are in fact useable together.

For example, claim 52 (group V) states that the means for elevating a temperature recited in claim 47 "is capable of elevating said temperature of said semiconductor devices to at least 125°C." The phrase "at least 125°C" means that the semiconductor devices may be heated to higher temperatures, including possibly 150°C, 175°C, and 200°C. Why is the means of claim 52 not usable with means capable of heating the semiconductor devices to 150°C, 175°C, and 200°C as stated in claims 53-55 (groups VI-VIII)?

As another example, why cannot terminals (claim 49 and Group II) be mounted adjacent a printed circuit board (claim 48 and Group I)? As yet another example, why cannot the contact structures recited in claim 47 be springs (claim 71 and Group XIV) that are elongate (claim 69 and group XII) and free standing (claim 70 and group XIII)? As still another example, why cannot semiconductor devices that are unpackaged dies (claim 72 and group XV) be elevated to at least 125°C (claim 52 and Group V), 150°C (claim 53 and Group VI), 175°C (claim 54 and Group VII), or 200°C (claim 55 and Group VIII)? Similar questions could be posed regarding every combination of the 15 inventions identified in the Restriction.

Thus, the Restriction requirement cannot stand for the additional reason that the inventions are not unrelated.

Applicants also note that, in a Restriction dated August 23, 2004, claims 48-59 were identified as drawn to one invention rather than the nine inventions identified in the most recent Restriction.

If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

Date: October 31, 2005

By _____
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